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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/248,178	02/09/99	REED S	210121.440C2

HM12/0718

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EXAMINER	
JOHNSON, N	
ART UNIT	**PAPER NUMBER**
1642	7

DATE MAILED: 07/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/248,178	Reed
Examiner	**Group Art Unit**
Nancy Johnson	1642

☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-52 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-52 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1, 7-9, 12-24, drawn to a polypeptide and pharmaceutical compositions, vaccines and fusion proteins comprising said polypeptide, classified for example, in class 530, subclass 350. Claim 18 will be examined with Group I to the extent that it reads on a polypeptide product.

II. Claims 2-6, 10-11, 15-16, 18, 41, 42, 45 and 46, drawn to polynucleotides and vaccines and pharmaceutical compositions comprising said polynucleotides, classified in class 536, subclass 23.1. Claim 18 will be examined with Group II to the extent that it reads on a polynucleotide product.

III. Claims 29-31, 34-40, drawn to an antibody, classified in class 530, subclass 387.1.

IV. Claims 47-49 drawn to composition of proliferating T cells, classified in class 435, subclass 325.

V. Claims 50-52, drawn to a composition of APC cells, classified in class 435, subclass 325.

VI. Claims 25-28, drawn to a method of detecting comprising contacting a sample with a binding agent that binds a polypeptide, classified, for example, in class 435, subclass 7.1.

VII. Claims 32, 33, 43, 44, drawn to a hybridization based detection method, classified in class 435, subclass 6.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-V are structurally and functionally different products which are made by different methods and have different uses. The examination of all groups would require different searches in the U.S. Patent Shoes and the scientific literature and would require the consideration of different patentability issues.

The methods of Groups VI and VII differ in the method objectives, method steps and parameters and in the reagents used.

Inventions II and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polynucleotide of Group II can also be used in *in vivo* gene therapy methods.

Inventions III and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case antibodies of Group I can also be used in *in vivo* treatment methods.

3. Groups II and VII are drawn to nucleotide and nucleotide constructs that contain more than ten individual, independent, and distinct nucleotide sequences in alternative form. Accordingly, Groups II and V are subject to restriction under 35 U.S.C. § 121 as outlined in 1192 O.G. 68 (November 19, 1996). **Thus, with the election of Group II or VII, applicant is required to specify no more than ten specific nucleotide sequences from SEQ ID NO:1-94 for examination.** This requirement is made under O.G. Notice 1192 O.G. 68 (November 19, 1996), as the examination of more than ten sequences in one application would result in an undue search burden on the PTO. The search of the no more than ten selected sequences may include the complements of the selected sequences and, where appropriate, may include subsequences within the selected sequences (*e.g.*, oligomeric probes and/or primers).

4. Groups I, III-V and VI are drawn to polypeptides encoded by SEQ ID NO:1-94 or methods of using said polypeptides. Each polypeptide is a structurally and functionally different product and the examination of more than one sequences would result in an undue search burden

on the PTO. Thus, with the election of Group I, III-V or VII, the applicant is required to select **one** SEQ ID NO: for examination.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Johnson whose telephone number is (703) 305-5860.

NANCY A. JOHNSON, PH.D
PRIMARY EXAMINER

July 10, 2000